

Patent
Attorney Docket No. ITW7510.008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Deonarine, Victor I.
Serial No. : 09/683,353
Filed : December 18, 2001
For : **DUAL TEMPERATURE INDICATOR STICK**
HOLDER
Group Art No. : 2859
Examiner : Jagan, M.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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SUPPLEMENTAL APPEAL BRIEF PURSUANT TO 37 C.F.R. §§1.191 AND 1.192

Dear Sir:

This Supplemental Appeal Brief is being filed pursuant to 37 CFR 1.193(b)(2)(ii) and in furtherance to the Notice of Appeal filed on December 22, 2003. Appellant

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hereby seeks reinstatement of the Appeal. Furthermore, this Supplemental Appeal Brief incorporates herein the relevant portions of the Appeal Brief filed February 23, 2004.

1. **REAL PARTY IN INTEREST**

The real party in interest is Illinois Tool Works Inc., the Assignee of the above-referenced application by virtue of the Assignment to Illinois Tool Works Inc., recorded on February 26, 2002, recorded at reel 012424, frame 0212.

2. **RELATED APPEALS AND INTERFERENCES**

Appellant filed an Appeal Brief on February 23, 2004. Responsive thereto, the Examiner reopened prosecution in an Office Action dated June 22, 2004. In the Office Action, the Examiner reiterated a plurality of the previously final rejections, presented a plurality of rejections based on newly considered references, and indicated the allowability of claims 4 and 7 over all previous rejections, and in particular, over OMEGAMARKER® Temperature Test Kit [hereinafter OMEGAMARKER®].

The Examiner re-opened prosecution and indicated the allowability of claims 4 and 7 and rejected claims 1, 6, 8, 16, and 18-20 under 35 U.S.C. §102(b) as being unpatentable over OMEGAMARKER®; rejected claims 1, 3, 5, and 6 under 35 U.S.C. §102(b) as being unpatentable over previously unconsidered reference Kossnar et al. (USP 6,022,159); rejected claims 1, 3, 5, 6, 8, and 9 under 35 U.S.C. §102(b) as being unpatentable over Kirk (USP 3,564,668); rejected claims 1, 3, 5, 6, and 8 under 35 U.S.C. §102(b) as being unpatentable over previously unconsidered reference Aronson (USP 4,244,660); rejected claims 2 and 17 under 35 U.S.C. §103(a) as being unpatentable over OMEGAMARKER® in view of previously unconsidered reference Peterson (USP 1,603,713); and rejected claims 10-15 under 35 U.S.C. §103(a) as being unpatentable over OMEGAMARKER® in view of Peterson. The Examiner further objected to claims 5 and 11-13 because of certain informalities. Appellant hereby presents this Supplemental Appeal Brief to supplement the Appeal Brief of December 22, 2003.

The undersigned is Appellant's legal representative in this Appeal. Illinois Tool Works Inc., the Assignee of the above-referenced application, as evidenced by the documents mentioned above, will be directly affected by the Board's decision in the pending appeal.

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3. STATUS OF THE CLAIMS

Claims 1-20 are currently pending. Claims 4 and 7 stand objected to but have been indicated allowable if rewritten in independent form. Claims 1-3, 5-6, and 8-20 have been at least twice rejected and, thus, are the subject of this appeal.

4. STATUS OF AMENDMENTS

Appellant has filed an Amendment to the June 22, 2004 Office Action concurrently herewith (a courtesy copy is included herein) to amend claim 11 to address an objection as to form made by the Examiner. Specifically, claim 11 has been amended to correct a lack of antecedent basis for the "second housing elements".

5. SUMMARY OF THE INVENTION AND OF THE DISCLOSED EMBODIMENTS

Incorporated herein by reference from the Appeal Brief filed February 23, 2004.

6. GROUND OF REJECTION

The Examiner has presented several new rejections over several newly cited references, presented new rejections over previously considered references, and reiterated multiple previous rejections. Claims 1, 6, 8, 17, and 18-20 stand rejected under 35 U.S.C. §102(b) by newly cited Kossnar et al. (USP 6,022,159); claims 1, 3, 5, 6, 8, and 9 stand rejected under 35 U.S.C. §102(b) by Kirk (USP 3,564,668); claims 1, 3, 5, 6, and 8 stand rejected under 35 U.S.C. §102(b) by newly cited Aronson (USP 4,244,660); claims 2 and 17 stand rejected under 35 U.S.C. §103(a) by OMEGAMARKER® in view of newly cited Peterson (USP 1,603,713); and claims 10-15 stand rejected under 35 U.S.C. §103(a) by OMEGAMARKER® in view of newly cited Peterson (USP 1,603,713).

As will be explained below, claims 1-3, 5-6, and 8-20 do not stand or fall together because at least each of these claims include or add subject matter that is patentably distinct from the art of record.

While Appellant acknowledges the Examiner's duty to discover relevant references, 37 C.F.R. §1.104(a)(1) states that "on taking up an application for examination ... the examiner shall make a thorough study thereon and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention." 37 C.F.R. §1.104(a)(1) (emphasis added). Title 37 C.F.R. §1.104(c)(2) further states that "[i]n rejecting claims for want of novelty or for

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obviousness, the examiner must cite the best references at his or her command." 37 C.F.R. §1.104(c)(2) (emphasis added). MPEP §707.02 states that "the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them." MPEP §707.02 (emphasis added). MPEP §904.03 further states that "[i]t is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search ... be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search." MPEP §904.03. MPEP §904.03 further states that "[i]n selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure to avoid the citation of an *unnecessary number*" and that "[m]ultiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided." Id. (emphasis added).

The Examiner has reopened prosecution in the above-captioned matter after four (4) Office Actions prior to Appellant filing the February 23, 2004 Appeal Brief. In reopening prosecution, the Examiner has applied three (3) new references and articulated rejections in which the Examiner acknowledges that the references do not include all that is called for in the claims. Additionally, not only is it apparent that the references do not include each and every element called for in the claims, but the references appear to be redundant with art already of record. This has resulted in prolonged prosecution and a burden to Appellant. Assuming that the previous search and examination were conducted in accordance with the provisions of the MPEP, 35 U.S.C., and 37 C.F.R. cited above, Appellant can only assume that the present plethora of new rejections are punitive in nature and are not in accord with proper patent practice as outlined in the statutes, the C.F.R., and the MPEP.

The Examiner has improperly rejected the pending claims. The Examiner has misapplied long-standing and binding legal precedents and principles in rejecting the claims under §102(b) and §103(a). Specifically, the art or record fails to disclose, teach, or suggest, individually or in any combination thereof, that which is called for in the

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present claims. Accordingly, Appellant respectfully requests full and favorable consideration by the Board and ultimate allowance of claims 1-20 as Appellant believes claims 1-20 are in condition for allowance. Hereinafter, each rejection of the claims will be addressed individually.

7. REJECTION UNDER 35 U.S.C. §102(b) OVER OMEGAMARKER®

CLAIMS 1 and 16:

The Examiner rejected claims 1, 6, 8, 16, and 18-20 under 35 U.S.C. §102(b) as being anticipated by OMEGAMARKER®. Responsive thereto, Appellant incorporates herein, by direct reference, those arguments submitted in the February 23, 2004 Appeal Brief. As argued herein, OMEGAMARKER® does not teach, suggest, or disclose a dual temperature indicator stick assembly as called for in the present claims. February 23, 2004 Appeal Brief, pgs. 4-17. As required under MPEP §2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131.

Responding to the arguments presented in the February 23, 2004 Appeal Brief, the Examiner states that "Applicant's arguments ... are not persuasive since claim 1 does not claim a dual temperature indicator stick." June 22, 2004, Office Action, pg. 10, ¶4. The Examiner further states that "[t]hese arguments are not persuasive since the recitation 'dual temperature indicator stick assembly' has not been given any patentable weight because the recitation only occurs in the preamble" and that "[a] preamble is generally not accorded any patentable weight where it *merely recites the purpose of a process or the intended use of a structure*, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone." Id (emphasis added).

Appellant does not disagree that a preamble that merely recites the purpose of a process or the intended use of a structure should not be afforded any patentable weight; however, the preambles of the present claims do not merely recite the purpose of a process or the intended use of the structure claimed therein. Claims 1 and 16 call for a dual temperature indicator stick assembly and apparatus, respectively. MPEP §2111.02 states that "[a] claim preamble has the import that the claim as a whole suggests for it"

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and that "[i]f the claim preamble, *when read in the context of the entire claim*, recites limitations of the claim, or, if the claim preamble is '*necessary to give life, meaning, and vitality*' to the claim, then the claim preamble should be construed as if in the balance of the claim." MPEP §2111.02 (emphasis added).

Each of claims 1 and 16 call for two temperature indicating structures. The preamble of each of the respective claims unifies the structure called for in the claims into an assembly, holder, or apparatus constructed to indicate two temperatures thereby forming the dual temperature indicator called for in the preamble of each of the claims. In neglecting the preamble of each of claims 1 and 16, the Examiner has disregarded that which gives life, meaning, and vitality to the claims as required under MPEP §2111.02. In essence, the Examiner is reading the claims out of context of what is specifically claimed -- a dual temperature indicator stick. This is not a writing pencil holder, nor a folder for paper that incidentally has writing pencil holders, nor is it a box that holds temperature indicator sticks when not in use. These claims all call for a DUAL TEMPERATURE INDICATING STICK in one form or another.

Regarding Appellant's arguments that the "case" of OMEGAMARKER® is not a "connector", February 23, 2004 Appeal Brief, pg. 5, ¶1 to pg. 6, ¶1, the Examiner states that "[a]ccording to Webster's Dictionary, 10th ed. 'connect' is defined as 'to join or fasten together usually by something intervening'" and that "the casing of OMEGA® is, by definition, is also a 'connector' since it connects together the holders of the test kit." June 22, 2004 Office Action, pg. 11, ¶1. Such an interpretation is only plausible by completely disregarding that which is called for in the preamble of each of the claims. That is, as previously argued in the February 23, 2004 Appeal Brief, in order for the temperature sensitive crayons of OMEGAMARKER® to indicate any temperature, a person of ordinary skill in the art would readily appreciate that the temperature sensitive crayons shown therein must be removed from the case, whereby eliminating any and all connection therebetween. Additionally, in order to indicate two different temperatures, a person of ordinary skill in the art would also readily appreciate that more than one temperature sensitive crayon would need to be removed from the case and would in no way be "connected" to the temperature sensitive crayon previously removed therefrom.

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Responsive thereto the Examiner states that Appellant's arguments "are not persuasive since the manner in which the assembly is to be used is not a structural limitation of the assembly" and that "the recitation 'dual temperature indicator stick assembly' has not been given any patentable weight because the recitation only occurs in the preamble...." June 22, 2004 Office Action, pg. 11, ¶ 2. First, if Appellant's arguments are not so persuasive, there is no need for reopening prosecution and issuing a plethora of new rejections, in the hope that something now sticks. Second, the preamble of each of the present claims is not merely a recitation of intended use but structurally defines that which is recited thereafter as an assembly, holder, or apparatus constructed to indicate two temperatures -- i.e. a dual temperature indicator stick assembly, holder, or apparatus, respectively. MPEP §2111.02 states that "[d]uring examination, statements in the preamble ... must be evaluated to determine whether the recited purpose or intended use results in a structural difference ... between the claimed invention and the prior art" and that "[i]f so, the recitation serves to limit the claim." MPEP §2111.02 (emphasis added). The Examiner incorrectly disregarded the preambles of the respective claims that form a dual temperature indicator stick assembly. Accordingly, Appellant requests favorable action over the rejection of claims 1 and 16 over OMEGAMARKER®.

CLAIM 6:

The Examiner further considered Appellant's arguments with respect to claim 6, See February 23, 2004 Appeal Brief, pg. 10, ¶ 2 to pg. 11, as non-persuasive stating that Appellant's arguments as not persuasive "since the housing are frictionally held in the 'channels' and therefore can be slidingly moved by applying an axial force at either end of the housing" and that "once the crayons wear down because of extensive use, there will be additional space for the housing to slide." June 22, 2004 Office Action, pg. 12, ¶ 1. The Examiner further states that "OMEGA® does not disclose the housing and crayon being in full contact at both ends with the 'channels', and therefore, does not preclude the housing from sliding even if only slightly." Id. Appellant respectfully disagrees.

Claim 6 further defines the dual temperature indicator stick assembly of claim 1 wherein the connector slidingly secures the first and second indicator stick housings in a side-by-side relationship. As previously argued, not only does the temperature test kit of

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OMEGAMARKER® not form a dual temperature indicator assembly, but the only relevant "disclosure" of OMEGAMARKER® related to claim 6 is the figure shown therein. See OMEGAMARKER®. To anticipate a claim, the reference must teach each and every element of the claim. See MPEP §2131. As most clearly shown by the indicator sticks positioned in the vertical portion of the case, each individual temperature indicator stick has a first end that abuts the upper end of each respective channel of the case and a second end that abuts the lower end of the associated channel. There is clearly no disclosure in OMEGAMARKER® that the connector slidingly secures the first and second indicator stick housings in a side-by-side relationship as called for in claim 6. Furthermore, as previously argued in the February 23, 2004 Appeal Brief, (see pgs. 4-8), a person of ordinary skill in the art would readily appreciate that when the temperature sensitive crayons of OMEGAMARKER® are positioned in the case disclosed therein, in order to indicate any temperature would require inserting a heated object into the case thereby destroying it. Such an interpretation is absurd and clearly not supported by OMEGAMARKER®. For all the reasons set forth above and those reasons provided in the February 23, 2004 Appeal Brief, Appellant believes claim 6 is patentably distinct over OMEGAMARKER® beyond the reasons for patentability of claim 1 from which it depends. Accordingly, Appellant requests favorable action over the rejection of claim 6 over OMEGAMARKER®.

8. REJECTION UNDER 35 U.S.C. §102(b) OVER KOSSNAR ET AL.

CLAIM 1:

Again, to anticipate a claim, the reference must teach each and every element of the claim. See MPEP §2131. The Examiner rejected claim 1 under 35 U.S.C. §102(b) over newly cited Kossnar et al. In rejecting claim 1 over Kossnar et al., the Examiner has merely reproduced claim 1 and disregarded that portion of claim 1 that is not shown in the art of record. Specifically, the Examiner states that "the term 'configured to' is not considered to be a positive limitation since it only requires the ability to so perform [...] [and that] it does not constitute a limitation in a patentable sense." June 22, 2004 Office Action, pg. 5, ¶ 2. Appellant notes that the Examiner has not provided any support for this interpretation.

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In rejecting claim 1 over newly cited Kossnar et al., the Examiner states that "the term 'configured to' is not considered to be a positive limitation since it only requires the ability to so perform...." June 22, 2004 Office Action, pg. 5, ¶ 2. Appellant respectfully disagrees. The American Heritage Dictionary, Second College Edition, Houghton Mifflin Company, ©1982, defines a configuration as "the arrangement of the parts or elements of something" or "the form of a figure as determined by the arrangement of its parts" That is, as recited in claim 1, the first and second indicator stick housings are configured to hold a compound which melts at a given temperature. That is, calling for a housing configured to hold a compound is not merely the ability to perform but further defines the housings as being constructed to hold the compound. In the context of claim 1, "configured to" is a structural limitation to perform the stated function. Kossnar et al. does not disclose any such compounds, is not configured according to the claim, and is, therefore, not a proper §102 rejection.

The Examiner further states that "the housings of Kossnar are 'configured' to hold a compound that melts at a given temperature since such a compound can be held by the housings, if so desired" and that "[i]t does not constitute a limitation in a patentable sense." June 22, 2004 Office Action, pg. 5, ¶ 1. Such an interpretation is clearly improper. Regardless of further defining the holders as being constructed, or configured, to hold a compound which melts at a given temperature -- which is not disclosed in Kossnar et al. -- as stated in MPEP §2173.05(g), "[t]here is nothing inherently wrong with defining some part of an invention in functional terms." MPEP §2173.05(g). MPEP §2173.05(g) further states that "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim...." Id. Additionally, MPEP §2131 states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 (emphasis added). In the context of claim 1, "configured to" is a structural limitation to perform the stated function. Kossnar et al. discloses a dual pen holder. The holder of Kossnar et al. is configured to hold pens. There is no disclosure in Kossnar et al. for the pen holder to hold anything other than a pen and specifically, there is no disclosure in Kossnar et al. for a holder configured to hold a compound which indicates

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any temperature let alone a compound which melts at a first given temperature and a compound which melts at a second given temperature as called for in claim 1. As such, at least for those reasons argued above, that which is called for in claim 1 is not shown or disclosed in Kossnar et al. Therefore, Appellant requests favorable action over the rejection of claim 1 over Kossnar et al.

CLAIM 3:

The Examiner rejected claim 3 stating that "wherein the connector comprises a longitudinal member having curved ends including curved sections that are configured to slidably secure the housing to the connector...." June 22, 2004 Office Action, pg. 5, ¶ 1. Appellant respectfully disagrees. Claim 3 further defines the dual temperature indicator stick assembly of claim 1 wherein the connector comprises a longitudinal member having curved ends, the curved ends configured to secure the first and second indicator stick housings to the connector. Referring to Fig. 1 of Kossnar et al., dividing wall 14 is disposed between adjacent pens 32a, 32b when the pens are positioned in tube casing 12. Kossnar et al., Fig. 1. As shown in Fig. 2 of Kossnar et al., the dividing wall includes a pair of oppositely facing concave curvatures 54. Kossnar et al., Fig. 2. Kossnar et al. states that "[t]he inner tube diameter of tubes 20a and 20b is slightly larger than the outer finger diameter 70 to frictionally engage the projections 62 and, thereby, enable pens 32a and 32b to be releasably retained within the pen holder 10." Kossnar et al., col. 3, lns. 61-65. That is, it is not the curved ends of the longitudinal member that secure the pens thereto, rather it is the engagement of the pens with the recess of the holder that secure the pens thereto. As such, claim 3, which calls for the curved ends of the longitudinal member to secure the first and second indicator sticks to the connector, is not shown or disclosed in Kossnar et al. At least for the reasons set forth above, Appellant believes claim 3 includes subject matter that is patentably distinct beyond that which is called for in claim 1. Accordingly, Appellant requests favorable action over the rejection of claim 3 over Kossnar et al.

CLAIM 5:

The Examiner rejected claim 5 under 35 U.S.C. §102(b) over Kossnar et al. without reference to that which is called for in claim 5. Claim 5 further defines the

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curved ends to include a pair of curved sections. As shown in Figs. 6 and 7 of the present application, each curved end 56 of connector 55, as shown in Fig. 6, is constructed to include a pair of curved sections 62 as shown in Fig. 7. There is no disclosure in Kossnar et al. for such a construction. As shown in Fig. 2., Kossnar et al. discloses a longitudinal member having a pair of concave curvature portions 54. Kossnar et al., Fig. 2. Kossnar et al. does not teach, suggest, or disclose that each of these concave curvature portions include a pair of sections as called for in claim 5. As such, Appellant believes claim 5 includes subject matter that is patentably distinct beyond that which is called for in claim 1. Accordingly, Appellant requests favorable action over the rejection of claim 5 over Kossnar et al.

CLAIM 6:

The Examiner also rejected claim 6 under 35 U.S.C. §102(b) over Kossnar et al. stating that the curved sections "are configured to slidingly secure the housing to the connector..." June 22, 2004 Office Action, pg. 5, ¶ 1. Appellant respectfully disagrees. While Appellant does not necessarily disagree that the pens of Kossnar et al. must be slid into the holder disclosed therein to be secured thereto; that is not what is called for in claim 6. Claim 6 calls for the connector slidingly securing the first and second indicator stick housings in a side-by-side relationship. That is, the first and second indicator stick housings are slidable while secured to the connector. Simply, the pens of Kossnar et al. are either secured to the housing or sliding relative thereto. They are not slidable and secured thereto. It is one or the other but not both as claimed in claim 6. As such, Appellant believes claim 6 includes subject matter that is patentably distinct beyond that which is called for in claim 1 over Kossnar et al. Accordingly, Appellant requests favorable action over the rejection of claim 6 over Kossnar et al.

9. REJECTION UNDER 35 U.S.C. §102(b) OVER KIRK**CLAIM 1:**

The Examiner rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by Kirk. Similar to the Examiner's rejection over Kossnar et al., the Examiner has again disregarded specific limitations called for in claim 1. As such, the Examiner's rejection is clearly improper. The Examiner states that "... the pencils of Kirk are 'configured' to

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hold a compound which melts at a given temperature" June 22, 2004 Office Action, pg. 6, ¶ 1. There is no such disclosure in Kirk. Kirk discloses a holder for pens and pencils. Kirk, col 1, ln. 12. There is no disclosure within the four corners of Kirk for a holder configured to hold a temperature indicating compound. Additionally, as clearly shown in Fig. 1 of Kirk, any pens or pencils positioned in holder 15 are to be removed therefrom during use. Kirk, Fig. 1. That is, the holder of Kirk is a storage apparatus for holding pencils and pens when not in use. Claim 1 calls for a dual temperature indicator stick assembly having a one-piece connector for physically connecting the first and second indicator stick housings along different axes. For use of the pens or pencils of Kirk, the instruments must be removed from the holder and do not form a dual writing instrument but a plurality of individual writing utensils.

The Examiner again states that "the term 'configured to' is not considered to a positive limitation since it only requires the ability to so perform [...] [and that [i]t does not constitute a positive limitation in a patentable sense." June 22, 2004 Office Action, pg. 6, ¶ 1. Appellant respectfully disagrees. As previously argued with respect to the rejection of claim 1 over Kossnar et al., the recitation of 'configured to' in claim 1 further defines the structure that is called for therein. The Examiner has provided no support for the interpretation that 'configured to', as called for in the present claims, merely requires the ability to so perform and can be ignored. Notwithstanding the Examiner's disregard for that which is called for in claim 1, there is no disclosure in Kirk that the pencils or pens disclosed therein are configured to hold a compound which melts at a first given temperature and a compound which melts at a second given temperature as called for in claim 1. As such, that which is called for in claim 1 is clearly not shown, taught, or disclosed in Kirk as is required to support a §102(b) rejection. See MPEP §2131. Accordingly, Appellant requests favorable action over the rejection of claim 1, and those claims that depend therefrom, over Kirk.

10. REJECTION UNDER 35 U.S.C. §102(b) OVER ARONSON

CLAIM 1:

The Examiner next rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by Aronson. Yet again the Examiner has disregarded elements of claim 1 with the

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unsupported interpretation that "configured to" merely requires the ability to so perform. With this interpretation, it is clear that the rejections are now duplicative in nature and have no purpose but to place an undue burden on Appellant.

The Examiner states that "the term 'configured to' is not considered to be a positive limitation since it only requires the ability to so perform" June 22, 2004 Office Action, pg. 6, ¶ 8. Assuming *arguendo* that "configure to" merely requires the ability to so perform, those limitations that follow "configured to" would necessarily, minimally, be functional limitations. If such is the case, not only must a functional limitation be evaluated and considered, just like any other limitation of the claim, but the reference must also disclose each and every element as set forth in the claim. See MPEP §2173.05(g). By the Examiner's own admission, Aronson does not show, disclose, or even suggest a holder configured to hold a compound which melts at a given temperature, let alone a compound which melts at a first given temperature and a compound which melts at a second given temperature as called for in claim 1.

Additionally, Aronson discloses that the container disclosed therein secures the marking instruments neatly in place when not in use. Aronson, Abstract. That is, to be used, i.e. to write with the utensils or 'indicate' anything, the utensils must be removed from the container. Claim 1 calls for a dual temperature indicator stick assembly. When the writing instruments of Aronson are removed from the container the user is left with a plurality of individual writing instruments and not a dual indicator stick assembly as called for in claim 1. As such, Aronson does not disclose (1) a housing configured to hold a compound which melts at a first temperature, (2) a housing configured to hold a compound which melts at a second temperature, and (3) a dual temperature indicator stick assembly having a one-piece connector physically connecting the first and second indicator stick housings. As such, minimally, three of the elements of claim 1 are not taught, shown, or even remotely suggested in Aronson. Therefore, Appellant requests favorable action over the rejection of claim 1, and those claims that depend therefrom, over Aronson.

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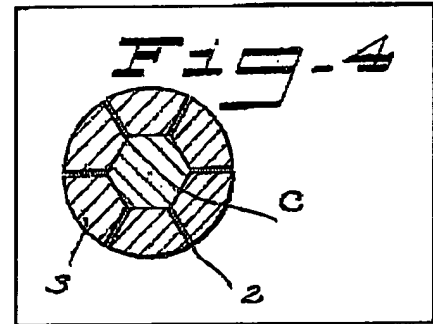
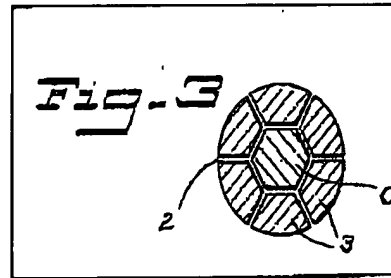
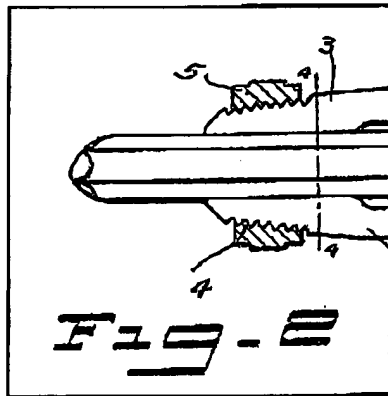
11. REJECTION UNDER 35 U.S.C. §103(a) OVER OMEGAMARKER® IN VIEW OF PETERSON

CLAIM 2:

The Examiner next rejected claim 2 under 35 U.S.C. §103(a) as being unpatentable over OMEGAMARKER® in view of Peterson stating that "Peterson teaches a mechanism for controlling the movement of a crayon with a holder." June 22, 2004 Office Action, pg. 7, ¶ 4. The Examiner further states that "[t]he mechanism comprises a collet (5) having threads for screwing onto the end of the holder" and that "[t]he end of the holder is provided with a plurality of resistance mechanisms (arms) that are pressed together against the crayon by the collet to engage the crayon...." June 22, 2004 Office Action, pg. 7, ¶ 4 (emphasis added). That is not what is called for in claim 2. In order to support a rejection under 35 U.S.C. §103(a) the combined references "must teach or suggest all the claim limitations." MPEP §2142 (emphasis added). In addition to the distinctions between claim 1 and OMEGAMARKER® addressed at the beginning of page 6 of the February 22, 2004 Appeal Brief and expressly incorporated herein, and the arguments presented above under the REJECTION UNDER 35 U.S.C. §102(b) OVER OMEGAMARKER, claim 2 calls for, in part, each of the pair of collets configured to engage separate indicator sticks. That is, it is the collet and not the housing that engages the temperature indicator sticks.

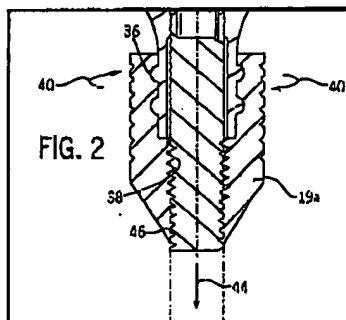
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As shown in Figs. 2, 3, and 4 of Peterson (reproduced above in whole or in part), fingers (3) engage crayon C when threaded clamping ring 5 is positioned thereabout. See Peterson pg. 2, lns. 5-20. Simply, the clamping means disclosed in Peterson requires an operator to loosen or remove the threaded clamping ring 5 in order to manually adjust the position of the writing instrument disposed therein. Whereas, as called for in claim 2, the collet engages the indicator stick positioned therein.

As the Examiner states, "the end of the holder is provided with a plurality of ...(arms) that are pressed together against the crayons by the collet to engage the



crayon...." Id. That is, the Examiner acknowledges that it is the arms, or fingers (3), of Peterson that engage the crayon disposed therein and not the threaded clamping ring (5). As shown at left, Fig. 2 (reproduced in part) of the present application clearly shows a collet 19a engaged with a temperature indicator stick passing therethrough. As such,

that which is called for in claim 2 is not taught or suggested by the art of record. Accordingly, Appellant requests favorable action over the rejection of claim 2 over the art of record.

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CLAIM 17:

The Examiner rejected claim 17 under 35 U.S.C. §103(a) over OMEGAMARKER® in view of Peterson. Claim 17 depends from claim 16. Appellant herein expressly incorporates the arguments related to the patentability of claim 16 over OMEGAMARKER® presented on page 11 under the heading, **Independent Claim 16**, of the February 23, 2004 Appeal Brief and the arguments presented herein under **REJECTION UNDER 35 U.S.C. §102(b) OVER OMEGAMARKER, CLAIM 16**. Appellant contends that claim 16 is allowable and therefore, claim 17 is allowable at least pursuant to the chain of dependency. Accordingly, Appellant requests favorable action over the rejection of claim 17 over the art of record.

CLAIM 10:

The Examiner rejected claims 10-15 as being unpatentable over OMEGAMARKER® in view of Peterson. The Examiner has once again merely reiterated some of the elements of the claims and disregarded others. Specifically, with reference to claim 13, the Examiner states that "the recitation of grooves are for engaging the end of a clamp to prevent rotational movement is considered to be a recitation of intended use of the grooves and has not been given patentable weight...." June 22, 2004 Office Action pg. 9, ¶ 2.

Claim 10 calls for, in part, a pair of advancement mechanisms wherein each of the pair of advancement mechanisms engages a respective temperature indicator stick upon rotation of a respective advancement mechanism. The Examiner acknowledges that "OMEGA® does not disclose the holder having advancement mechanisms configured to extend the sticks from the connector assembly, wherein the advancement mechanisms engage a respective stick upon rotation of the advancement mechanism" June 22, 2004 Office Action pg. 8, ¶ 4. Appellant does not disagree. The Examiner further states that:

Peterson discloses a device for holding a crayon. Peterson teaches a mechanism for controlling the movement of the crayon within a holder. The mechanism comprises an advancement mechanism (a collet (5)) having threads for screwing onto the end of the holder. The end of the holder is provided with a plurality of resistance mechanisms (arms) that are pressed together against the crayon by

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the collet to engage the crayon. June 22, 2004 Office Action, pg. 8, ¶ 6.

As the Examiner states, the "(arms) [...]" are pressed together against the crayon by the collet to engage the crayon." Id. That is, it is not the collet of Peterson that engages the crayon but the arms of the housing. As shown in Fig. 2 of Peterson, there is no engagement between clamping ring 5 and crayon C positioned therein. Peterson, Fig. 2. It is apparent that the housing – or the fingers thereof – maintain a separation therebetween. As such, that which is called for in claim 10, wherein the advancement mechanism engages a temperature indicator stick, is not shown, taught, or disclosed in the art of record.

Claim 10 further calls for a pair of advancement mechanisms configured to extend the two temperature indicator sticks from the connector assembly. Simply, it is not any structure of OMEGAMARKER® or Peterson that extends the two temperature indicator sticks from the connector assemblies disclosed therein. That is, upon loosening the clamping ring 5 of Peterson, an operator must tip or rotate the holder disclosed therein to extend the crayon therefrom. As shown in Fig. 2 of the present application, advancement mechanism 19a engages the temperature indicator stick positioned therein to extend the temperature indicator stick from the connector assembly. The clamping ring 5 and the fingers 3 of Peterson, as shown in Fig. 2, do not engage or extend the crayon position therein from shell 1. Peterson, Fig. 2. As such, that which is called for in claim 10 is not shown, taught, or disclosed in the art of record. Therefore, claim 10, and those claims that depend therefrom, are patentably distinct over the art of record. Accordingly, Appellant requests favorable action over the rejections thereto.

CLAIM 13:

The Examiner rejected claim 13 under 35 U.S.C. §103(a) over OMEGAMARKER® in view of Peterson stating that "the housings of OMEGA® have a groove thereon." June 22, 2004 Office Action, pg. 9, ¶ 2. Claim 13 calls for each housing element to have a groove on an outer surface to engage an end of a clamp and prevent rotation of the first and second housing elements. The only grooves disclosed on OMEGAMARKER® are annular and in the same direction of insertion of the indicator

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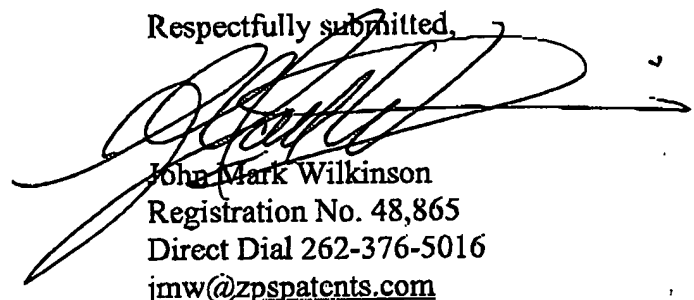
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sticks into the case disclosed therein. As such, there is no support for the conclusion that the grooves formed on the case of OMEGAMARKER® prevent rotation of the first and second housing elements. The Examiner again disregards this limitation recited in the claim stating that "the recitation that the grooves are for engaging the end of the clamp to prevent rotational movement is considered to be a recitation of intended use of the grooves and has not been given any patentable weight" *Id.* As argued extensively herein throughout, such an interpretation is clearly improper and does not comport with the requirements of patentability set forth in the MPEP. The groove does not merely recite intended use but further defines the structure of the housing elements that is not taught, shown, or disclosed in the art of record. Accordingly, Appellant requests favorable action over the rejection to claim 13 over the art of record.

12. CONCLUSION

In view of the above remarks, Appellant respectfully submits that the Examiner has provided no supportable position or evidence that claims 1-20 are anticipated or obvious in light of the art of record. The Examiner has acknowledged and expressly stated, as cited herein, that elements of the claims have been disregarded and that the references do not show such elements. Accordingly, Appellant respectfully requests withdrawal of all outstanding rejections and the present application be passed to issuance.

Respectfully submitted,



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APPENDIX OF CLAIMS ON APPEAL

1. (Previously Presented) A dual temperature indicator stick assembly comprising:

a first indicator stick housing positioned along a first axis and configured to hold a compound which melts at a first given temperature;

a second indicator stick housing positioned along a second axis and configured to hold a second compound which melts at a second given temperature; and

a one-piece connector physically connecting the first and second indicator stick housings along different axes.

2. (Original) The dual temperature indicator stick assembly of claim 1 further comprising:

a pair of resistance mechanisms attached to one of the first and second indicator stick housings to limit rotational movement of the first and second indicator sticks;

a pair of collets having threads, each collet rotatably coupled to one of the first and second housings; and

wherein each of the pair of collets is configured to engage separate indicator sticks upon rotation of a collet about one of the first and second axis.

3. (Previously Presented) The dual temperature indicator stick of claim 1 wherein the connector comprises a longitudinal member having curved ends, the curved ends configured to secure the first and second indicator stick housings to the connector.

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4. (Original) The dual temperature indicator stick of claim 3 wherein the curved ends have hooks configured to engage the first and second indicator stick housings to prevent rotation of the first and second indicator stick housings.

5. (Original) The dual temperature indicator stick of claim 3 wherein each of the curved ends includes a pair of curved sections.

6. (Original) The dual temperature indicator stick of claim 3 wherein the connector slidably secures the first and second indicator stick housings in a side-by-side relationship.

7. (Previously Presented) The dual temperature indicator stick of claim 4 wherein the first and second indicator stick housings have an exterior surface having a groove therein for engaging the hooks of the curved ends of the longitudinal member.

8. (Previously Presented) The dual temperature indicator stick of claim 1 wherein the connector is configured to snap fit the first and second indicator sticks to the connector.

9. (Original) The dual temperature indicator stick of claim 1 wherein the connector includes a clip member configured to permit attachment of the dual temperature indicator stick assembly to an object.

10. (Original) A dual temperature indicator stick holder comprising:
a connector assembly adapted to receive and position two temperature indicator sticks in a side-by-side relationship;

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a pair of advancement mechanisms configured to extend the two temperature indicator sticks from the connector assembly; and

wherein each of the pair of advancement mechanisms engages a respective temperature indicator stick upon rotation of a respective advancement mechanism.

11. (Previously Presented) The dual temperature indicator stick holder of claim 10 wherein the connector assembly includes a first housing element connected to a second element, each of the first and second housing elements having a single advancement mechanism secured thereto and capable of holding a temperature indicator stick therein.

12. (Original) The dual temperature indicator stick holder of claim 11 wherein the connector assembly further includes a pair of resistance mechanisms attached to one of the first and second housing elements to limit rotational movement of the two temperature indicator sticks.

13. (Previously Presented) The dual temperature indicator stick holder of claim 11 wherein the first and second housing elements each has a groove on an outer surface to engage an end of a clamp and prevent rotation of the first and second housing elements.

14. (Original) The dual temperature indicator stick holder of claim 10 wherein the connector assembly includes a clamp to align two temperature indicator stick housing elements along different axes.

15. (Original) The dual temperature indicator stick holder of claim 14 wherein the clamp has a longitudinal member having curved ends, the curved ends

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configured to slidingly secure the two temperature indicator stick housing elements in a side-by-side relationship.

16. (Original) A dual temperature indicator stick apparatus comprising:
first means for indicating a first temperature;
second means for indicating a second temperature; and
means for retaining the first means to the second means in a side-by-side relationship to form an indicator stick assembly capable of indicating at least two temperatures.

17. (Original) The apparatus of claim 16 further comprising a means for controlling movement of the first and second means.

18. (Original) The apparatus of claim 16 wherein the first and second means comprises a first temperature indicator stick and a second temperature indicator stick.

19. (Original) The apparatus of claim 16 wherein the means for retaining the first means to the second means comprises a pair of tubular members secured together by a connector.

20. (Original) The apparatus of claim 19 wherein the connector includes a longitudinal member having curved ends integrally molded to each of the tubular members.

21-24 (Canceled)